

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN DALE GOODMAN, JAMES PATRICK HOFF,
RANDALL SCOTT SPRINGFIELD, and JAMES PETER WARD

Appeal 2008-0076
Application 09/931,629
Technology Center 2100

Decided: August 15, 2008

Before LANCE LEONARD BARRY, CAROLYN D. THOMAS, and
STEPHEN C. SIU, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

ORDER REQUIRING THE APPELLANTS
TO BRIEF AN ADDITIONAL MATTER

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-4 and 6-10. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b) and exercise our jurisdiction to address two issues.

II. INCORPORATION BY REFERENCE

It is essential that the Board be provided with a brief fully stating the position of the appellant with respect to each ground of rejection presented for review in the appeal so that no search of the record is required in order to determine that position. Thus, *the brief should not incorporate or reference previous responses.*

MPEP § 1205.02 (8th ed. Rev. 5 Oct. 2005 (emphasis added)).¹

Here, the Appellants' Appeal Brief incorporates the Trusted Computing Platform Alliance ("TCPA") Specification (App. Br. 2.) and the "Applicants' previous response of July 15, 2005" (*Id.* 4.) Such incorporation is improper.

¹ We cite to the version of the Manual of Patent Examining Procedure in effect when the Appellants filed their Appeal Brief. The current version includes the same provisions.

III. SUMMARY OF CLAIMED SUBJECT MATTER

An Appeal Brief must include "[a] *concise* explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters." 37 C.F.R. § 41.37(c)(1)(v)(2005) (emphasis added).²

Here, incorporating the TCPA Specification (App. Br. 2) as aforementioned, the Appellants' *Summary of Claimed Subject Matter* is far from concise. Although the *Summary* cites to "Page 10, lines 11-17" (*id.* 4 (emphasis added)) of the Appellants' Specification, moreover, page 10 thereof comprises only twelve lines of text.

IV. CONCLUSION

Because of the aforementioned issues, we are persuaded that "[t]he appeal is manifestly not ready for a decision on the merits." *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (BPAI 1999).

V. ORDER

"We decline to substitute our speculation for the greater certainty that should come from the Appellants." *Ex Parte Dietz*, No. 2007-2386, 2008 WL 696147, at *2 (BPAI 2008). Instead, they must file a Substitute Appeal Brief that corrects the aforementioned defects. More specifically,

² We cite to the version of the Code of Federal Regulations in effect when the Appellants filed their Appeal Brief. The current version includes the same rules.

the Substitute Brief should omit incorporation of and reference to prior responses and the TCPA Specification. It should also cite only to extant lines of the Appellants' Specification.

The Substitute brief must repeat every argument that the Appellants want considered. Any argument made in their earlier briefs not so repeated will be waived. No prior briefs should be referenced or incorporated therein.

Under 37 C.F.R. § 41.50(d), we give the Appellants a non-extendable time period of thirty days within which to respond to this order. Failure to comply with the order within that time may result in the *sua sponte* dismissal of this appeal. 37 C.F.R. § 41.50(d).

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

ORDERED; 37 C.F.R. § 41.50(d)

rwk

Robert A. Voigt, Jr.
WINSTEAD SECHREST & MINICK PC
PO BOX 50784
DALLAS TX 75201